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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/863,882

05/23/2001

Takaaki Amano

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18.691)

9462

7590

10/27/2005

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EXAMINER

LASTRA, DANIEL

ART UNIT

PAPER NUMBER

3622

DATE MAILED: 10/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/863,882

Applicant(s)

AMANO ET AL.

Examiner

DANIEL LASTRA

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6,9 and 10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6,9 and 10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-6, 9 and 10 have been examined. Application 09/863,882 has a filing date 05/23/2001 and foreign information 05/24/2000.

Response to Amendment

2. In response to Non Final Rejection filed 05/12/2005, the Applicant filed an Amendment on 08/12/2005, which amended claims 1-6, 9 and added new claim 10.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 3, 4 and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1, 3, 4 and 6 recite the limitation "decreasing said point number as a total number of points accumulated for said advertisement increases". Said claims do not explain the meaning of points accumulated for said advertisement increases. For purpose of art rejection said limitation would be interpreted as decreasing the value provided to a user for displaying an advertisement based upon the amount of times said user has seen said advertisement.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, 4 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldhaber (US 5,855,008) in view of Roth (US 6,285,987).

As per claim 1, Goldhaber teaches:

A server apparatus for applying one or more incentive points by which a service can be received in response to an amount of said points to be used in a Web site, comprising:

network means for connecting a first apparatus and a second apparatus, said first apparatus being related to a person who shares cost required to provide the service (see column 8, lines 59-62), and said second apparatus being related to a person who applies said points (i.e., advertiser; see column 8, lines 59-62; column 10, lines 39-67);

applicable point number storage means for calculating an applicable point number based upon a point number responding to the cost shared by the person related to the first apparatus which is notified from said first apparatus, and also an applied point number, and for storing there into the calculated applicable point number (see column 10, lines 39-67);

advertisement storage means for storing there into information used to display an advertisement with respect to the person concerning said first apparatus (see column 10, lines 39-67);

display point determining means for determining a point number to be displayed on said advertisement within said applicable point number in accordance with a predetermined rule (see column 10, lines 40-67);

web server means for producing a web page which displays said advertisement with respect to the person concerning said first apparatus, to which the determined point number has been applied under a selectable condition, and for displaying the produced web page on said second apparatus (see column 5, line 57 – column 6, line 7); and

applied point managing means for storing there into said displayed point number applied to said advertisement and an identifier for said second apparatus in relation to each other when the selection of said advertisement is accepted from said second apparatus (see column 10, lines 40-67; column 11, lines 32-45).

Goldhaber fails to teach that said predetermined rule *includes decreasing said point number as a total of points accumulated by said advertisement increases*. However, Roth teaches a system where each advertiser indicates one or more proposed bids which specify how much said advertiser is willing to pay based on the accumulated amount previously paid. For example, if the amount paid reaches a certain number, the subsequent ads will be paid at a lower rate. Five cents will be paid for the first 1,000 ads and four cents for any ads after 1,000 (see Roth column 5, lines 55-63). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that an advertiser using the Goldhaber system would specify the type of users (i.e. view-op) whom said advertisers would want an ad shown (see Goldhaber column 14, lines 39-42) and said advertiser would vary the compensation pay to said users (i.e. bid amount) based upon said users' viewing characteristics (i.e. "view-op"; how many times a user has viewed an advertisement within a particular time), as taught by Roth. An Advertiser using the Goldhaber's system

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would be motivated to decrease the amount of compensation pay to users (i.e. view-op) that has already seen said advertiser's ads in view that said advertiser would have an advertisement's budget limit with limited resources (see Roth column 10, lines 55-60) where said limited resources would be used to display said ads to new potential customers by offering a bigger compensation for viewing said ads to users that have never seen said ads.

As per claim 3, Goldhaber teaches:

A program product capable of operating a computer as such a server apparatus for applying one or more incentive points by which a service can be received in response to an amount of said points to be used in a web site, wherein said program product causes the computer to execute:

a network process for connecting a first apparatus and a second apparatus, said first apparatus being related to a person who shares cost required to provide the service (see Goldhaber column 8, lines 57-61), and said second apparatus being related to a person who applies said points (see Goldhaber column 8, lines 57-61; "advertiser"; see column 10, lines 40-67);

an applicable point number storage process for calculating an applicable point number based upon a point number responding to the cost shared by the person related to the first apparatus, and also an applied point number which is notified from said first apparatus, and for storing there into the calculated applicable point numbers an advertisement storage process for storing there into information used to display an

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advertisement related to the person concerning said first apparatus (see column 10, lines 40-67; column 11, lines 25-45);

a display point determining process for determining a point number to be displayed on said advertisement within said applicable point number in accordance with a predetermined rule (see column 10, lines 40-67);

a web server process for producing a web page which displays the advertisement related to the person concerning said first apparatus, to which the determined point number has been applied under selectable condition, and for displaying the produced Web page on said second apparatus (see column 5, line 42 – column 6, line 8); and

an applied point managing process for storing there into said displayed point number applied to said advertisement and an identifier for said second apparatus in relation to each other when the selection of said advertisement is accepted from said second apparatus (see column 11, lines 25-45). Goldhaber fails to teach that said predetermined rule *includes decreasing said point number as a total of points accumulated by said advertisement increases*. However, the same argument made in claim 1 is made in claim 3 regarding said missing limitation.

As per claim 4, Goldhaber teaches:

A method for applying to an advertisement viewer, one or more incentive points by which a service can be received in response to an amount of said points to be used in a Web site, comprising:

a step in which as to cost which is notified via a network from an advertisement provider who snares cost required to provide a service, an applicable point number is calculated based upon both a point number in response to the cost shared by the advertisement provider and also a point number which has been applied to the advertisement viewer, and then, the calculated applicable point number is stored in an applicable point number storage means (see column 10, lines 40-67; column 11, lines 9-45):

a step in which a point number to be displayed on the advertisement of said advertisement provider is determined within the applicable point number in accordance with a point applicable rule which has been previously stored in the storage means (see column 10, lines 40-67);

a step in which a web page which displays the advertisement of said advertisement provider, to which the determined point number is applied, under selectable condition to the advertisement viewer, is produced and then, the produced web page is transmitted to a terminal of the advertisement provider (see column 10, lines 40-67; column 5, line 40 – column 6, line 8) and

a step in which when said advertisement is selected by the terminal of said advertisement provider, both the point number applied to said advertisement and the advertisement viewer are stored into a storage means in relation to each other (see column 10, lines 40-67; column 11, lines 25-45). Goldhaber fails to teach that said predetermined rule *includes decreasing said point number as a total of points*

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accumulated by said advertisement increases. However, the same argument made in claim 1 is made in claim 4 regarding said missing limitation.

As per claim 6, Goldhaber teaches:

A service providing method for providing a service to a customer responsive to one or more incentive points applied by the customer when an order by the customer is accepted in on-line shopping for accepting an order via a network, wherein:

a cost sharing person who shares cost as to said service corresponds to a person who invests his money in a sales person who sells goods in the on-line shopping (see column 8, lines 59-62; column 10, lines 40-67); and

said cost sharing person is separated from the sales person (see column 10, lines 40-67; column 8, lines 59-62; advertisers and service providers);

wherein the sales person executes a process operation causing an advertisement with respect to the cost sharing person to be presented under a selectable condition to the customer prior to the acceptance of the order by the customer (see column 10, lines 40-67; column 11, lines 7-45); and

a point application to a customer is carried out by accepting the selection of the advertisement with respect to said cost sharing person, which is presented under *said* selectable condition (see column 10, lines 40-67; column 11, lines 7-45). Goldhaber fails to teach that said predetermined rule *includes decreasing said point number as a total of points accumulated by said advertisement increases*. However, the same argument made in claim 1 is made in claim 6 regarding said missing limitation.

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Claims 2, 5, 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldhaber (US 5,855,008) in view of Roth (US 6,285,987) and further in view of Ikeda (US 5,937,391).

As per claim 2, Goldhaber teaches:

The server apparatus as claimed in claim 1, but fails to teach wherein said server apparatus further comprises: online shopping means and said service responding to the amount of said points to be used corresponds to a discount service of purchased goods in the online shopping. However, Ikeda teaches a point-service system, where users redeem earned points by receiving discounts on products bought in an online shopping mall (see Ikeda column 2, lines 29-67). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that advertisers would compensate users with credits or coupons (i.e. points), for viewing particular advertisements, as taught by Goldhaber (see Goldhaber column 11, lines 25-32) and said users would redeem said earned points by purchasing certain products offered in an online shopping mall, as taught by Ikeda. This feature would serve as a users' incentives to view certain advertisements, as said users would receive discounts on products for said viewing.

As per claim 5, Goldhaber teaches:

The point applying method as claimed in claim 4 wherein said point applying method is further comprises but fails to teach:

a step for accepting a purchase proposal of goods via a network and said service responding to the amount of said points to be used corresponds to a discount service of

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goods purchased in on-line shopping. However, Ikeda teaches a point-service system, where users redeem earned points by receiving discounts on products bought in an online shopping mall (see Ikeda column 2, lines 29-67). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that advertisers would compensate users with credits or coupons (i.e. points), for viewing particular advertisements, as taught by Goldhaber (see Goldhaber column 11, lines 25-32) and said users would redeem said earned points by purchasing certain products offered in an online shopping mall, as taught by Ikeda. This feature would serve as a users' incentives to view certain advertisements, as said users would receive discounts on products for said viewing.

As per claim 9, Goldhaber teaches:

The service providing method as claimed in claims 6 but fails to teach wherein the service responding to the amount of said points is to discount a purchase price of goods ordered through the on-line shopping. However, Ikeda teaches a point-service system, where users redeem earned points by receiving discounts on products bought in an online shopping mall (see Ikeda column 2, lines 29-67). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that advertisers would compensate users with credits or coupons (i.e. points), for viewing particular advertisements, as taught by Goldhaber (see Goldhaber column 11, lines 25-32) and said users would redeem said earned points by purchasing certain products offered in an online shopping mall, as taught by Ikeda. This feature

would serve as a users' incentives to view certain advertisements, as said users would receive discounts on products for said viewing.

As per claim 10, Goldhaber teaches:

A server comprising:

a web page display arrangement for producing a web page which displays an advertisement including a point number based on a predetermined rule (see figure 11);

an applied point manager for storing the point number applied to the advertisement and identifier for a user who selects the advertisement, the applied point manager applying the points as a discount between the user and a retailer (see column 11, lines 25-32); and

Goldhaber fails to teach a network arrangement adapted to communicate with a user and to allocate a cost of the discount from the retailer to an advertiser. However, the same argument made in claim 2 regarding said missing limitation is also made in claim 10. Goldhaber fails to teach wherein the predetermined rule includes decreasing the point number each time the user or another selects the advertisement. However, the same argument made in claim 1 regarding said missing limitation is also made in claim 10.

Response to Arguments

5. Applicant's arguments with respect to claims 1-6, 9 and 10 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

6. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720. The examiner can normally be reached on 9:30-6:00.

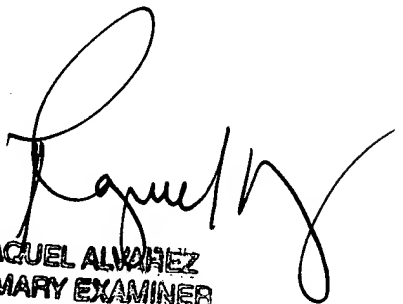
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W. STAMBER can be reached on 571-272-6724. The Examiner's Right fax number is 571-273-6720.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DL

Daniel Lastra

October 15, 2005


RAQUEL ALVAREZ
PRIMARY EXAMINER